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Applicant : Mark R. Williams

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Serial No. : 09/652,387

Examiner : Debbie M. Le

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Title : METHODS AND APPARATUSES FOR MEDIA FILE DELIVERY

Commissioner for Patents

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Unofficial

FAX RE: FINAL OFFICE ACTION

Please note – this fax is intended to provide some background information prior to an upcoming Examiner interview. The information contained herein is written in a simplified and concise manner for the convenience of the Examiner. The issues present in the final office action are addressed here in layman's terms to make the points more clear. As such, the precise wording and examples used below are not intended to impose limitations on the invention.

There are two primary references cited in the office action: Berry and Simmons. The following are the three main arguments of the Applicant in response to this prior art.

Argument #1 – Berry is not applicable to the invention

Berry describes a system that has little relevance to the invention disclosed in the Applicant's claims. The Berry invention addresses retrieving multimedia content to enhance or enrich a CD listening experience. For example, if a person is listening to a song by the Beatles, the system will identify the song by its identifier, and then use that identifier to locate multimedia content relevant to the particular Beatles song that is being played. For instance, the system may retrieve and then display images and/or video of the Beatles that can enhance the experience for the user. The "identifiers" used by Berry identify a song. All copies of the same song have the same identifier.

Completely different from the Berry invention is the Applicant's invention, which addresses illegal copying of songs. The invention is simply this: if a user is listening to a legal copy of a song, the song plays with no interruptions; if, however, a user is listening

to an illegal copy of a song, the user must first listen to an advertisement before the song will play.

To accomplish this, each user's media player has a unique identifier. The "identifier" identifies a media player (e.g., an MP3 player); no two media players have the same identifier. When a user legally downloads a song, the media player identifier is appended to the song. Then if the user plays the song in her own media player, the identifier on the song will match the identifier for the media player and the song plays with no interruptions. The media player verifies that the song has the same identifier as the media player itself.

Now, if the song is illegally copied to a new media player, the song will have an identifier that does not match the identifier for the new media player. This is because no two media players have the same identifier. The song will still play in this new media player, however, an advertisement will play first before the song.

Hopefully the above was clear. If not, the following example should help.

Example of the Applicant's invention:

Mary owns an MP3 player, and the MP3 player has an identifier that reads "abcd". Mary legally downloads the song "Happy Birthday" into her MP3 player. When she does this, the song file has the identifier "abcd" appended to it. When Mary plays the song in her MP3 player, it plays with no interruptions. This is because the identifier for Mary's MP3 player matches the identifier appended to the song.

Steve owns an MP3 player as well, and his MP3 player has an identifier that reads "wxyz". Mary now gives Steve a copy of the song "Happy Birthday" that she downloaded. This is an illegal copy since Steve did not buy it himself. When Steve inserts the song into his MP3 player, his MP3 player sees that the "Happy Birthday" song has the identifier "abcd" appended to it. Since Steve's MP3 player has the identifier "wxyz", the MP3 player determines that the song came from another unit. Therefore, Steve's MP3 player plays an advertisement first, and then plays the song. Steve still gets to hear the song, but since he obtained the song illegally, he must first listen to the advertisement.

Therefore, considering that the Berry patent discloses something completely unrelated to the Applicant's invention, the Applicant strongly believes that Berry cannot be used to reject the Applicant's claims. No one of ordinary skill in the art who is addressing music piracy issues would think to look at Berry for help since Berry simply discloses adding multimedia content to CDs.

**Argument #2 – Berry and Simmons cannot be combined**

As described above, Berry is completely unrelated to the subject matter of the Applicant's invention. Therefore, Berry cannot be combined with Simmons to reject the Applicant's claims.

**Argument #3 – Simmons and Berry do not disclose certain claim limitations as argued by the Examiner**

The Examiner has described portions of Berry and the Simmons patent application as disclosing elements recited in the Applicant's claims. Applicant respectfully notes, however, that this is simply not true. Applicant will demonstrate this with regard to claims 1 and 11.

**Regarding claim 1:**

Regarding claim 1 in the final office action, the Examiner stated that "Berry does not explicitly teach appending an identifier onto the media file, wherein the identifier uniquely identifies a player unit. However, Simmons teach appending an identifier onto the media file the identifier uniquely identifies a player unit (see section 0022, 0040)."

Contrary to the Examiner's assertions, Simmons does NOT disclose appending an identifier that uniquely identifies a player unit. Instead, Simmons discloses a local encryption key. Even if the local encryption key is unique to the player unit, it does not identify the player unit, and the encryption key is not appended to the song. Rather, the song is encrypted using the key. This is a critical difference as explained below.

Claim 1 requires that the identifier identify the player unit, and that this identifier be appended to the song. Neither of these limitations is disclosed in Simmons. Claim 1 is very different from Simmons because by appending the identifier to the song, rather than encrypting it, the song can still be played on other player units. In Simmons, if the

song is moved to another player unit, the song cannot be decrypted and therefore cannot be played.

Because Simmons does not disclose appending an identifier to the song, and because the identifier does not identify the player unit, the Applicant respectfully submits that Simmons does not disclose these limitations of claim 1.

Regarding claim 11:

Regarding claim 11 in the final office action, the Examiner stated that "Berry teaches...retrieving a message file and producing a message output from the message file if the first identifier does not correspond to the second identifier (col. 10, lines 32-38).

Again, Applicant respectfully notes that this statement is not correct. Upon a careful reading of Berry, the Examiner will see it actually states that "if no codes are found to match...then the process ends" (col. 10, lines 32-33). Contrary to this, in claim 11 if the first identifier does not correspond to the second identifier the process does not end. In fact, the process is lengthened because a message file must now be retrieved and played if the first identifier does not correspond to the second identifier. Berry therefore teaches away from claim 11 and does not disclose this limitation as argued by the Examiner.

Furthermore, Simmons does not disclose this limitation as well. In Simmons, if the player unit cannot decrypt a song, the song simply cannot be played. There is no discussion anywhere of playing a message file, such as an advertisement, if the song cannot be decrypted.

Conclusion:

To put it quite simply, although Simmons and the Applicant's invention both disclose methods for addressing piracy issues in downloading music, they work in very different ways. Simmons uses encryption to make sure only the legal owner of the music can play the music. The user buys a song, the song is encrypted specifically for that user's player unit, and therefore only the user can play the song. If someone else tries to play the encrypted song, the song cannot be decrypted and will not play.

The Applicant's invention is different. In the Applicant's invention, the song is not encrypted; therefore anyone can play the song. The song does, however, have an identifier appended to it. So when someone other than the legal owner tries to play the song, they have to listen to an advertisement (i.e., message file) before they can listen to the song. Neither Simmons nor Berry disclose this idea, even in combination. As such, these references cannot be used to support a 103 rejection of the Applicant's claims.